

*In re* Application of Briere, *et al.*  
Re-Issue Application Serial No. 09/553,413  
Filed April 20, 2000  
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39. A mold assembly for use in manufacturing molded thermoplastic containers comprising:

two mold shells each containing a half-impression of a substantial portion of the container to be molded;

24 two mold shell holders each defining a cavity for receiving each said respective mold shell such that each said respective mold shell is in at least partial mutual thermal-conduction contact with its respective shell holder, said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures/movable one with respect to the other; and

at least one quick-fixing, slidable lock by which at least one of said mold shells is removably secured to a respective one of said mold shell holders, said slidable lock being slidable into and out of a locking position which at least partially locks said one of said mold shells relative to said respective mold shell holder.

#### REMARKS

This Amendment is filed in response to the Office Action dated April 11, 2003. The Applicants have amended the claims in order to more clearly recite the claimed invention. The Applicants intend to appeal if this rejection is made final, and therefore prompt action in response to this paper is requested.

The Examiner has required a cross-reference to reissue application no. 09/902,475, which is a continuation of the present application. A cross-reference in the form suggested has been added as the first sentence of the specification.

In the claims, after the phrase "in the form of enveloping structures" the phrase --movable one with respect to the other-- found in patent Claim 1 has been added in claims 15, 35, 36, and 39. Support in the disclosure may be found in column 1, line 11.

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In the Office Action, the Examiner has again withdrawn an indication of allowance and rejected previously allowed claims 15-21 and 34-40 as being an improper recapture of subject matter surrendered during prosecution of the original Patent. The indication of allowance was contained in the following description of the substance of the interview conducted on January 9, 2003:

Mr. Young pointed out that the surrendered form of the claim in Patent application 08/945,089 [the original prosecution] positively recited "by two mold carriers". That claim in the patent application was amended to recite "which are in the form of enveloping structure". The reissue claim has been amended to add "said shell holders being shaped to be supported by two mold carriers in the form of enveloping structures". Hence, the reissue claim is narrower than the surrendered subject matter (original presentation of claim in Patent application) in an aspect germane to the prior art rejection and broader in an aspect unrelated to the prior art rejection, that is, broader in that it claims the corresponding subcombination (mold assembly). Reference was made to MPEP section 1412.02 and page 1400-15 citing *In re Clement*, 45 USPQ2d 1165. Since the claims in the reissue application already recite the limitation "said shell holders being shaped to be supported by two mold carriers in the form of enveloping structures", the recapture rejection is hereby withdrawn and the case [is] in condition for allowance.

The Examiner now has returned to his previous position that "the absence of the mold carriers in the shape of enveloping structures [as a positive structural element] from [the subcombination claims] constitutes recapture as this limitation was amended and argued to overcome a prior art rejection. *See In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997)." While citing *In re Clement*, the Examiner has improperly denied the Applicants all possibility of adding subcombination claims in this reissue application, by failing to apply the detailed test of *In re Clement* that the Examiner relied upon in the Interview Summary.

The Applicants traverse this rejection and will respond below by (1) detailing their position on the law of recapture, (2) pointing out the Office's published position on statutory

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category broadening in a reissue application, and then (3) applying the appropriate tests to the limitations of the present reissue claims.

#### The Recapture Test

MPEP 1412.02 "Recapture of Canceled Subject Matter" sets out a two step test based on *In re Clement*, and also cites the rule of *In re Clement* for "[r]eissue claims that are broader in scope in certain aspects, and narrower in others vis-à-vis claims canceled from the original application to obtain a patent." (MPEP p. 1400-15). The first step is to determine whether and in what respect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. The court in *In re Clement* includes in the term "surrendered subject matter" original application claims as they stood prior to being amended or canceled.

When a reissue claim is broader in some aspects and narrower in others than a "surrendered" original application claim, the court stated:

(a) if the reissue claim is as broad as or broader [than the surrendered claim] in an aspect germane to a prior art rejection, but narrower [than the surrendered claim] in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower [than the surrendered claim] in an aspect germane to [a] prior art rejection, and broader [than the surrendered claim] in an aspect unrelated to the rejection, the recapture rule does not bar the claim, . . .

Thus, one must carefully consider what limitations remain in the reissue claim to distinguish the prior art, and how the reissue claim actually differs from the surrendered claim prior to amendment.

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Reissue Claims in Corresponding Statutory Categories

One way in which a reissue claim can be broadened is to recast it in a different statutory category. MPEP 1412.02 includes a section entitled "Reissue for Article Claims Which are Functional Descriptive Material Stored on a Computer-Readable Medium" (page 1400-15), which states:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention . . . .  
(Underlining added).

As an example, consider a patented process claiming steps carried out by software (receiving data, creating an instruction, operating a device responsive to the instruction) and the corresponding article claim (a computer-readable medium having computer-executable instructions for performing steps comprising: receiving data, creating an instruction, operating a device responsive to the instruction). Note that to infringe the article claim, one need only record the computer-executable instructions on a medium – one need not actually perform the steps. The ability to cause a computer to perform the steps is only a characteristic of the recorded instructions, but that characteristic distinguishes the prior art in a way that corresponds to the steps of the process. In this example, if the step of operating a device had been added to the process claim to overcome a prior art rejection, surely the broadening reissue to add the article claim would still be permitted, because the broadening is in an aspect (changing statutory category) unrelated to the rejection.

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Of course, broadening by recasting an invention in a different statutory category is subject to the recapture doctrine. But, one cannot conclude that an Applicant surrendered the ability to claim the invention via a different statutory category unless there is evidence of an admission that the invention in the new statutory category format could not be patentable.. Authority for the proposition that an intentional admission is required to find that subject matter was surrendered can be found in *In re Clement*, citing *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984) and several cases listed in MPEP 1412.02. Thus, an amendment in a claim drafted in one statutory category to avoid prior art must not be presumed to be an admission that a "corresponding" claim in another statutory category has been surrendered. Rather, the recapture investigation should be directed to determining whether the claims are "corresponding."

#### The Present Subcombination Claims

Patented Claim 1 is directed to a device for manufacturing containers and includes the limitation "two half-molds . . . respectively supported by two mold carriers . . . which are made in the form of enveloping structures . . . ." Claim 15 of this reissue application is directed to an article, that is, a mold assembly for use in manufacturing molded thermoplastic containers and includes a corresponding limitation "two mold shell holders . . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures."

Turning to step 1 of the recapture test, Claim 15 is broader than the patented claim only in its statutory category (mold assembly vs. manufacturing device). The same characteristic that distinguished the invention from the prior art in the patented claim (the mold carriers being in the form of enveloping structures) is a characteristic of the mold shell holders of reissue Claim 15 (they are shaped to be supported by mold carriers made in the form of enveloping structures). If an article subcombination claim corresponding to patent Claim 1 (without the quick-fixing locking member) had been submitted in the original prosecution, and only the prior art then

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available had been considered, the subcombination claim would have been allowed for the same reasons the manufacturing device claim was allowed. Therefore, the only manner in which reissue Claim 15 is broader than patent Claim 1 stems directly from the difference in statutory category.

The Examiner states that reissue Claims 15, 35, 36 and 39 are broader than patent Claim 1 despite the limitation "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures," because Applicants argue that the mold carriers are not structural elements of the claim. The Applicants admit that these reissue claims are broader than the patent claim, but disagree with the Examiner's conclusion as to the respect in which they are broader. The shifting of the "enveloping structure" limitation from a characteristic of the mold carrier element of patent Claim 1 to a characteristic of the mold shell holders is a necessary result of shifting statutory claim categories, not a result of dropping a limitation added to overcome a rejection. The limitation remains in these reissue claims.

Reference to the MPEP discussion of "Reissue for Article Claims Which are Functional Descriptive Material Stored on a Computer-Readable Medium" clearly supports the Applicants' position. The article limitation at issue in these reissue claims corresponds to the manufacturing device limitation in the same way that a software article claim limitation corresponds to a software process limitation in the example above. In the software example, an infringing disc maker need not carry out the steps of the process, but the recorded instructions must cause the steps to occur when the instructions are run on a computer. In the present case, a mold assembly maker need not provide the mold carriers, but the mold shell holders must be shaped to be supported by two mold carriers in the form of enveloping structures when the mold shell holders are used in a container manufacturing device. As in the case of the software example, the broadening in the present reissue is only in respect to the statutory claim category.

The second step of the recapture test is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Here, the question is whether the Applicants

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surrendered the ability to claim the invention of patent Claim 1 as an article subcombination. There is no evidence in the record of the original prosecution from which to infer such an admission. In the present office action, the Examiner does not address this issue. He concludes that because the mold carrier element of the patent claim had been amended to overcome a prior art rejection, the absence of mold carriers as a structural element of the reissue claims in question is alone sufficient to support a recapture rejection. To the contrary, the limitation added to distinguish the prior art in the original prosecution has not been removed from the reissue claims. These claims do correspond to the patented container manufacturing device, and do not violate the recapture rule because there is no evidence the Applicants surrendered the broader aspect thereof.

In particular, the Applicants contend that reissue Claims 15, 35, 36 and 39 are narrower than the surrendered original claim in an aspect germane to the prior art rejection. That is, they require "said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures." It cannot be denied that this limitation narrows such reissue claims as compared to the surrendered claim. And, these reissue claims are broader than the surrendered claim only in an aspect unrelated to the rejection. That is, they recast the invention as a corresponding article claim directed to the mold shell holder assembly. Therefore, since the Applicants did not surrender their ability to claim the invention in a claim directed to the mold shell holder, application of the test of *In re Clement* leads to the conclusion that the recapture rule does not bar these claims.

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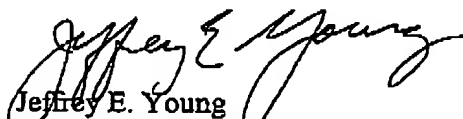
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Conclusion

In light of the foregoing claim amendments and remarks, this Reissue Application should be in condition for immediate allowance. The Applicants intend to appeal if the rejection is maintained; therefore the Applicants request a prompt indication whether the present arguments have overcome the rejection.

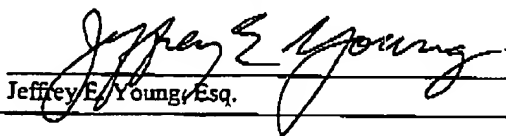
The Applicant does not believe that any fees are required. However, in the event that any fees or extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a) and any fee required is hereby authorized to be charged to Deposit Account 16-0605.

Respectfully submitted,

  
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office  
at Fax No. 703-872-9310 on the date shown below.

  
Jeffrey E. Young, Esq.

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